

REMARKS

Reconsideration of this application is respectfully requested. Applicants believe that consideration of this amendment is proper because they have attempted to comply with every requirement expressly set forth in the previous Office Action dated December 16, 2009 (Paper No. 20091211) and believe the application is now in condition for allowance.

Paragraph 2 of the outstanding office Action states that "Claims 1-9 and 15-17 are pending in the application, claims 15-17 have been cancelled." Applicants suggest that this paragraph should have read, in part, that claims 10-14 have been cancelled. If this assumption is not correct, Applicants respectfully request clarification as to when claims 15-17 were cancelled.

Claim 1 has been amended to specify that the aggregate is pressed into the surface of the starch gel and mineral wool core composition prior to drying it. Support for this amendment is found in original claim 10 and in the specification on page 6, lines 24-30.

Claims 1 through 9 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over Kahara et al. (U.S. Patent No. 5,753,871) in view of Baig (U.S. Patent Application Publication No. 2002/0139611) and Forry (U.S. Patent No. 4,585,685). The Applicants respectfully traverse. As argued previously, and as admitted by the Examiner,

neither of these references discloses aggregate particles that are pressed into the front surface of the acoustical tile.

Forry is cited as teaching a tile that is coated with aggregate particles that are pressed into the front surface of the tile. The Applicants respectfully submit that Forry does not teach embedding of particles as in the Applicants' invention. Forry is directed towards the deposition of particles onto a dry ceiling tile that is formed using a dry-form process as noted in that reference as follows:

Accordingly, one object of the present invention is to provide a dry-formed product which has a facing having a pleasing appearance, yet which is acoustically porous.

Column 2, lines 16-19.

This dry-formed composite has a totally different structure that holds the aggregate entirely unlike the way it is held in Applicants' product. The composite is made of a non-woven web whereby fibrous material and an organic binder are intermixed, then blown or spun to form a web or batt such as a fiberglass batt. The composite is covered with the aggregate particles. Pressure is then applied to the combined web and particles, pushing the aggregate down into the web between the fibers.

As stated by Forry:

In order for the aggregate material to be embedded in the fibrous material, the web must be resilient enough that it can deflect so as to permit the aggregate to be forced into the web surface and at least partially surrounded by the web constituents. Thus, when the consolidation and curing process is complete, the aggregate material will be firmly adhered to the web. Nevertheless, because the aggregate material will have pore spaces between the particles through which air can pass, and because the web will retain openings between the fibers, the resulting composite material will remain acoustically porous.

Column 5, lines 17-28.

This passage describes the difference between the structure of Forry and that of Applicants' tile. The aggregates of Forry are held in place by becoming entangled in the fibers of the web, while air freely passes between the fibers.

Applicants' amended claims clarify that the aggregate was deposited on the surface of the starch gel and mineral wool composition prior to drying. Placement of the aggregate particles on the wet-laid surface results in deformity of the starch gel. The gel flows around a portion of the particle to hold it in place. Due to the presence of the wet gel, there will not necessarily be pore spaces between all of the particles as in Forry. As a result of the diverging methods of making the product, a product having a different structure is produced.

The differences in the product were clearly recognized by Forry. Forry specifically states that the deposition of aggregate on tiles made using a wet-laid process is problematic and produces undesirable properties as noted in that reference as follows:

Aggregate facing materials have not been successfully used to produce acoustical materials because the facing materials cannot be adequately adhered to the board when it is in the wet state. This may occur because the consolidation which causes the aggregate to adhere to the wet board results in a densification of the board so that it is no longer acoustical, and/or because the faced boards cannot be fissured to render them acoustically porous without substantially interfering with the appearance of the board. When aggregate is

Column 1, lines 42-51.

In this passage, Forry teaches that application of aggregates to a board in the wet state densifies the board, prevents fissuring and results in aggregate not adhering to the board. Thus Forry believed that these differences in structure resulted in limited acoustical properties of the wet-laid product.

Applicants contend that there is no motivation for combining Forry with the substrate of Baig or Kahara. One of ordinary skill in the art would not look to Forry to suggest pressing aggregate into a wet-laid surface. As can be seen in the passage above, Forry specifically teaches away from embedding aggregates to boards made using a wet-laid process. In addition, neither Forry nor Baig mentions the use of rollers as a pressing means. In light of the foregoing and since the Office notes that Kahara is deficient in its teachings, the Applicants respectfully submit that Kahara, Baig and Forry alone or in combination do not teach, disclose or suggest the invention claimed by the Applicants.

Applicants have shown that no prima facie case of obviousness has been established. The prior art fails to disclose pressing of aggregate particles onto a front surface of an acoustical tile to make the same structure as taught by Applicants. There is

no motivation to press the aggregate of Forry into the wet-laid tile of Baig or Kahara since Forry teaches that doing so does not produce an acoustical tile. Applicants respectfully request that this rejection be withdrawn and the subject claims be allowed to issue.

The Applicants believe that there are further reasons why the rejections of Claims 1 through 9 based on Kahara in view of Baig and Forry under 35 USC §103(a) should be withdrawn, but the Applicants assert that the foregoing arguments are sufficient to overcome the rejections. Nonetheless, the Applicants reserve the right to provide further arguments in traversal of the rejections in any future responses to Office actions or in any appeals.

Claims 1 through 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cotts (U.S. Patent No. 3,184,372) in view of Baig and Forry. As admitted by the Examiner, Cotts fails to disclose a front surface of the ceiling tile coated with aggregate particles. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the arguments asserted above with regard to Baig and Forry are reasserted here. The product formed by the method of Forry would have a different structure than that claimed by Applicant. Further, there is no motivation to combine Forry with Cotts and Baig for reasons discussed above. Therefore, no *prima facie* case of obviousness has been established. In light of the foregoing, Applicants respectfully submit that Cotts, Baig and Forry alone or in

combination do not teach, disclose or suggest the invention claimed by the Applicants. Reconsideration of the claims is respectfully requested.

Applicants believe that there are further reasons why the rejections of Claims 1 through 9 based on Cotts in view of Baig and Forry under 35 USC §103(a) should be withdrawn, but the Applicants assert that the foregoing arguments are sufficient to overcome the rejections. Nonetheless, the Applicants reserve the right to provide further arguments in traversal of the rejections in any future responses to Office actions or in any appeals. Consequently, the Applicants respectfully submit that the Application is in condition for allowance.

By the above arguments and amendments, Applicants believe that they have complied with all requirements expressly set forth in the pending Office Action. Issuance of a Notice of Allowance on the remaining allowed claims is respectfully requested. Should the Examiner discover there are remaining issues which may be resolved by a telephone interview, she is invited to contact Applicants' undersigned attorney at the telephone number listed below.

If a Petition under 37 C.F.R. §1.136(a) for an extension of time for response is required to make the attached response timely, it is hereby petitioned under 37 C.F.R. §1.136(a) for an extension of time for response in the above-identified application for the period required to make the attached response timely. The Commissioner is hereby authorized to charge fees which may be required to this

In re Application of Mayers et al.
Application Ser. No. 10/789,000
Response to Office Action dated December 16, 2009
Amendment dated March 19, 2010

application under 37 C.F.R. §§1.16-1.17, or credit any overpayment, to Deposit Account No. 07-2069.

Respectfully submitted,
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